

### **REMARKS**

By this Amendment, Applicants amend claims 17, 21, 22, and 23, and cancel claims 7 and 9 without prejudice or disclaimer of the subject matter thereof. Claims 17-23 are pending in this application.

In the Office Action, the Examiner objected to claims 9, 21, and 22 due to informalities; rejected claims 7, 9, 17, 18, and 23 under 35 U.S.C. § 103(a) as being unpatentable over “R2V: Advanced Raster to Vector Conversion Software for Automated Map Digitizing” (“R2V”) in view of Dawson et al. (U.S. Patent No. 4,876,651); rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over “R2V” in view of “Accuracy Assessment of Mapping Products Produced from the Star-3i Airborne IFSAR System” (“Accuracy Assessment”); and rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable over “R2V” in view of “Accuracy Assessment” and in further view of Blackmer (U.S. Patent No. 6,505,146).

With regard to the objection to claim 9, although Applicants disagree with the objection, Applicants have canceled claim 9 in an effort to forward prosecution in this case. In addition, regarding the objection to claims 21 and 22, Applicants have amended these claims for further clarity. Accordingly, Applicants request that the Examiner withdraw the objection to claims 9, 21, and 22.

Applicants respectfully traverse the rejection of claims 7, 9, 17, 18, and 23 under 35 U.S.C. § 103(a) as being unpatentable over “R2V” in view of Dawson, and note that, with respect to canceled claims 7 and 9, the rejection is moot. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See

M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8<sup>th</sup> ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001).

Claim 17 recites a combination including, among other things, "means for marking a first point pair on the display, one point being on each map" and "means for marking a second point pair on the display, one point being on each map, the corresponding points of the point pairs having the same geographic location on each map." "R2V" and Dawson, whether taken alone or in combination, do not disclose or suggest at least these elements of claim 17. Instead, "R2V" discloses that a user must "write down the coordinate values (X, Y) displayed at the bottom of the window for the point in the target image window." See "R2V," page 3. Once a control point is defined, a user then must "enter the coordinate values ... for the target image window in the 'To' fields." See "R2V," page 3. Accordingly, "R2V" does not teach or suggest that a user may "mark[] a first point pair on the display, one point being on each map" and may "mark[] a second point pair on the display, one point being on each map," as recited in claim 17.

Dawson does not make up for the above-noted deficiencies of "R2V," and Applicants further note that the Examiner has not cited or discussed Dawson in the rejection of claim 17. Where the Examiner did address Dawson, in connection with the

rejection of claim 17, the Examiner alleged that the reference teaches “a storage platform being coupled to the processing platform” and “a storage platform being coupled to the processing platform for storing at least a digital raster map.” See Office Action, pages 3 and 4. Even if the Examiner’s allegation were correct, Dawson does not make up for the above-described deficiencies of “R2V”. Accordingly, “R2V” and Dawson, whether taken alone or in combination, do not disclose or suggest all of the elements of claim 17.

Claim 17 also recites “means for computing a georeferencing function based on pixel coordinates of the first point of each point pair and geographic coordinates of the second point of each point pair.” The Examiner alleges that “R2V” teaches these elements at page 2. See Office Action, page 4. Applicants respectfully disagree. “R2V” discloses that once control points are defined, “R2V provides several ways for geo-referencing using control points. If you use GeoTIFF, you can use Save Image As command and select Yes when asking if save as a GeoTIFF file.” See “R2V,” page 2. This general description of selecting options, however, does not constitute “means for computing a georeferencing function based on pixel coordinates of the first point of each point pair and geographic coordinates of the second point of each point pair,” as recited in claim 17.

Applicants also note that a prior art reference must be enabling, just as a U.S. patent must be enabling under 35 U.S.C. § 112, first paragraph. See *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 665, 231 U.S.P.Q. 649, 653 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 933 (1987); *In re Moreton*, 288 F.2d 708, 711, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961). “R2V,” however, does not teach one of

skill in the art how to georeference an image or how the control points are used. Instead, the reference merely indicates that a user selects to save a map as a "GeoTIFF file." As noted above, the Examiner has not relied upon Dawson for these features as well. Accordingly, Applicants respectfully submit that the rejection of claim 17 is improper for at least these additional reasons. The Examiner should therefore withdraw the rejection.

Claim 18 depends from allowable claim 17. Accordingly, the Examiner should also allow claim 18 at least due to its dependence.

Claim 23, while of a different scope, includes recitations similar to those of claim 17. For example, claim 23 recites "facilities for marking a first point pair on the display, one point being on each map; facilities for marking a second point pair on the display, one point being on each map, the corresponding points of the point pairs having the same geographic location on each map" and "facilities for computing a georeferencing function based on pixel coordinates of the first point of each point pair and geographic coordinates of the second point of each point pair." Accordingly, the Examiner should allow claim 23 for at least the same reasons as given for claim 17.

Applicants respectfully traverse the rejection of claim 19 under 35 U.S.C. § 103(a) as being unpatentable over "R2V" in view of "Accuracy Assessment." The Examiner applied "Accuracy Assessment," alleging that the reference discloses "means for executing a validation check of the georeferencing function pursuant to a standard deviation technique." See Office Action, page 5. Even if the Examiner's allegation were correct, which Applicants do not concede, "Accuracy Assessment" does not disclose or suggest at least "means for marking a first point pair on the display, one point being on

each map; means for marking a second point pair on the display, one point being on each map, the corresponding points of the point pairs having the same geographic location on each map” and “means for computing a georeferencing function based on pixel coordinates of the first point of each point pair and geographic coordinates of the second point of each point pair,” as recited in claim 17. Since claim 19 depends from claim 17 and includes all the elements thereof, “R2V” in view of “Accuracy Assessment” does not disclose or suggest all elements required by claim 19. The Examiner should thus withdraw the rejection of claim 19 under 35 U.S.C. § 103(a) for at least this reason.

Moreover, claim 19 recites that “more than two point pairs are identified and are used to compute the georeferencing function pursuant to a transformation technique.” The Examiner has not shown that the asserted references disclose or suggest at least this feature, which provides an incremental improvement in the georeferencing function with each added point pair. Furthermore, Applicants’ claimed “standard deviation technique” takes into account actual point placement in relation to predicted point placement as well as point dispersion. Accordingly, the Examiner should withdraw the rejection of claim 19 for at least this additional reason.

Applicants respectfully traverse the rejection of claim 20 under 35 U.S.C. § 103(a) as being unpatentable over “R2V” in view of “Accuracy Assessment” and in further view of Blackmer (U.S. Patent No. 6,505,146). The Examiner applied Blackmer, alleging that the reference discloses “rejecting a point pair when the point pair deviates by an amount exceeding a predetermined standard error.” See Office Action, page 5.

Even if the Examiner’s allegation were correct, which Applicants do not concede, Blackmer does not disclose or suggest at least “means for marking a first point pair on

the display, one point being on each map; means for marking a second point pair on the display, one point being on each map, the corresponding points of the point pairs having the same geographic location on each map” and “means for computing a georeferencing function based on pixel coordinates of the first point of each point pair and geographic coordinates of the second point of each point pair,” as recited in claim 17. Claim 20 depends from claim 17 and includes all the elements thereof, “R2V” in view of “Accuracy Assessment” and in further view of Blackmer does not disclose or suggest all elements required by claim 20. The Examiner should therefore withdraw the rejection of claim 20 under 35 U.S.C. § 103(a).

#### **CONCLUSION**

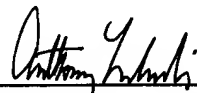
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 16, 2005

By:   
\_\_\_\_\_  
Anthony J. Lombardi  
Reg. No. 53,232